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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,132	07/25/2001	Jeffrey T. Randall	SEA0820P1120US	5741

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EXAMINER

JACYNA, J CASIMER

ART UNIT PAPER NUMBER

3751

DATE MAILED: 09/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/915,132

Applicant(s)

RANDALL, JEFFREY T.

Examiner

J. Casimer Jacyna

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36,38-54 and 71-78 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-26 and 77 is/are allowed.
- 6) ☒ Claim(s) 27-36,38-54,71-76 and 78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 July 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 23 July 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other: _____

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1. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.
2. The corrected or substitute drawings were received on 7/23/2002. These drawings are acceptable.
3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The following claim terms were not found in the patent: "a continuously curving first sealing surface", "first sealing surface", "a continuously curving second sealing surface" and "second sealing surface".
4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
5. Claims 27-36, 38-54, 71-76 and 78 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no antecedent basis for both the continuously curving first and second sealing surfaces in the specification. Surface 80 appears to be the continuously curving first sealing surface. However, there does not appear to be any continuously curving second surface that seals in surface to surface contact with surface 80 as

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currently claimed in the original patent. Consequently, this structure appears to be new matter.

6. Claims 27-36, 38-54, 71-76 and 78 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is no antecedent basis for the term "continuously curving second sealing surface" in the specification. Consequently, one of ordinary skill in the art would not be able to determine with reasonable certainty what the "continuously curving second sealing surface" is with regard to the specification and drawings. Therefore, one of ordinary skill in the art would be unable to determine with reasonable certainty what are the metes and bounds of the rejected claims because the structure and appearance of the second sealing surface is not properly disclosed.

7. Claims 71-76 and 78 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35

U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

In regard to claims 71 and 78, each claim of patent 5,938,087 included the limitation of a pry-off lid that "seals against an outside of said spout" (claims 1, 18 and 22), or is "arranged to seal around an outside of said spout" (claim 13). This limitation was not present in the originally filed claims, but was added to each claim in the amendment of 1/15/1999. Additionally, in the amendment of 1/15/1999, Applicant specifically argued on page 7, lines 16 and 21, that this limitation of the lid sealing on the outside of the spout was specifically added to overcome the Song et al. reference which did not include a lid which sealed on the outside surface (as stated on line 21). On page 8, lines 20-21, Applicant again contended the lid sealing on an external surface of the spout and stated this limitation overcame the De Nervo reference. Therefore, Applicant added the contested limitation in response to a rejection of the claims, and specifically identified this limitation as not being present in the cited prior art and also identified this limitation as a primary reason for allowing all of the claims of patent 5,938,087. Therefore, Applicant is barred from recapturing this omitted limitation from the claims because the broader scope was surrendered in the application, regardless of whether or not the limitation was actually needed to overcome the rejections. Applicant contends that the limitation was not listed in the examiner's reasons for allowance. However, the limitation did clearly claim around structure present in the prior art references, and was clearly cited by Applicant as a reason for allowing the claims. The examiner is not required to redundantly repeat remarks made

by Applicant in allowing the claims and typically will only state any additional salient reasons for allowance. Note that a reasons for allowance by the examiner is not required if Applicant's remarks are deemed to be complete. In the parent application, the examiner chose to add additional reasons to those cited by the Applicant. However, the reasons added by the examiner did not obviate those listed by Applicant.

In regard to the former 251 rejections of claims 27, 38 and 47;

Claims 27 and 38 define the interior to include a meniscus forming spout with an internal conduit of a substantially constant open area plus a continuously curving first sealing surface. Since the interior is claimed as being a conduit of substantially constant area, then claiming an additional continuously curving first sealing surface becomes another way of defining the originally claimed outside sealing surface since the only shown continuously curving sealing surface is on the outside of the spout. Also, since the interior is a conduit of constant area, it cannot be a continuously curving surface. Likewise, claim 47 also defines a continuously curving first sealing surface with an internal tubular passage, an internal surrounding ring portion and an internal deck portion that together define an internal recess for holding liquid wherein the claimed internal structure precludes a continuously curving sealing surface. Therefore, the claim wording becomes an alternate manner of claiming the originally claimed outside sealing surface.

8. Claims 1-26 and 77 are allowed.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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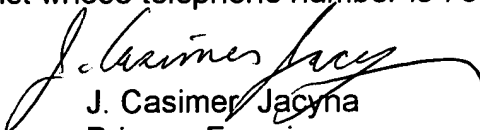
§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Casimer Jacyna whose telephone number is 703-308-1508. The examiner can normally be reached on Mon.-Fri. 10AM-2PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on 703-308-1382. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7766 for regular communications and 703-308-7766 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.


J. Casimer Jacyna
Primary Examiner
Art Unit 3751

JCJ
August 29, 2002